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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,386	10/11/2001	Kenneth David Knapp	24-01	1255

7590 06/04/2004

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2900 Two Thousand Market Street
Philadelphia, PA 19103

EXAMINER

A, PHI DIEU TRAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,386

Applicant(s)


KNAPP, KENNETH DAVID

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/15/04 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2, 4, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ernest (6444289).

Ernest (figure 2) shows a blanket of fibrous building insulating comprising a fibrous insulation layer (18) of a predetermined thickness having opposite first and second insulation surfaces between side surfaces that are spaced apart a given dimension which first and second insulation surfaces define the predetermined thickness, a thin facing sheet (20) having first and second sheet surfaces spaced apart a dimension that is substantially less than the predetermined thickness determined by the spacing apart of the insulation first and second surfaces with the first sheet surface thereof disposed on a second insulation surface (18a) of the insulation layer, a thin adhesive layer (24) substantially thinner than the thickness of the insulation layer disposed between and securing the first sheet surface of the facing sheet to the second insulation surface of the insulation layer, a grid of perforations (26) through the facing sheet, spots of adhesive visible through the perforations at the second sheet surface of the facing sheet (col 4 line 15-17), the grid of perforations comprising means defining generally straight predetermined cut lines for cutting the facing sheet and insulation in accordance with a pattern defined by at least some of the spots of adhesive, the blanket of insulation may be readily be cut along a line of the spots of adhesive to accommodate spaces between spaced apart structural members of lesser spacing than the given dimensions (inherently so), the insulation layer being of fiberglass construction (col 3 line 26-27), the grid of perforations being of rectangular, intersecting horizontal and vertical lines of spaced apart perforations, the grid of perforations comprising four vertical, generally spaced apart cut lines, the grid of perforations comprising horizontal, generally parallel, spaced apart cut lines.

Per claim 8, Ernest shows all the claimed method steps of making a blanket of fibrous building insulation. Ernest's structure also inherently can function as claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ernest (6444289) in view of Broderick et al (4709523).

Ernest shows all the claimed limitations except for the adhesive being asphalt.

Broderick et al discloses asphalt adhering an insulation layer (18) to a covering layer (11).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ernest to show the adhesive being asphalt because asphalt would provide strong bond between an insulation layer and its cover as taught by Broderick et al.

5. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernest (6444289).

Ernest shows all the claimed limitations except for the grid of perforation having cut lines being approximately 3 inches apart between side surfaces of the insulation layer, the grid of perforations having cut lines approximately 3.75 inch apart between side surfaces of the insulation layer, the grid of perforations having horizontal cut lines approximately 1.5 inch apart.

It would have been an obvious matter of design choice to show the grid of perforation having cut lines being approximately 3 inches apart between side surfaces of the insulation layer, the grid of perforations having cut lines approximately 3.75 inch apart between side surfaces of

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the insulation layer, the grid of perforations having horizontal cut lines approximately 1.5 inch apart because it would have been an obvious matter of design choice to show the perforations having cut lines approximately 3, 3.75, or 1.5 inch apart since applicant has not disclosed that the various spacing dimensions solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the perforations being spaced apart any desired dimension, and the fact that it is a matter of design choice is further illustrated by applicant's claims which call for the variety of dimensions between perforations.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ernest (6444289) in view of Ryan (649363).

Ernest shows all the claimed method steps except for the step of fastening a portion of the cut blanket of fibrous building insulation in the predetermined spacing between structure members.

Ryan (figure 1) shows the step of fastening a portion of the cut blanket of fibrous building insulation in the predetermined spacing between structure members.

7. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ernest to show the step of fastening a portion of the cut blanket of fibrous building insulation in the predetermined spacing between structure member because the step would allow the insulation blanket to cover the spacing between structure members as taught by Ryan.

Response to Arguments

8. Applicant's arguments filed 3/15/04 to claims 1-9 have been fully considered but they are not persuasive.

Applicant states that the intended use in the product claim must be accorded patentable significance, examiner respectfully disagrees as the claimed structural limitations are met by the reference Ernest and Ernest's structure is capable of performing the intended use. The perforations in Ernest certainly can function as guidelines. Also, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Ernest appears to satisfy the conditions set forth in the above court case.

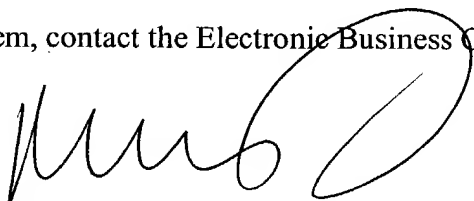
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Phi Dieu Tran A', with a large, loopy flourish at the end.

Phi Dieu Tran A

5/28/04